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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,873	01/19/2001	Hongsheng Su	104385.132	9057

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HALE AND DORR, LLP  
60 STATE STREET  
BOSTON, MA 02109

EXAMINER

HUTSON, RICHARD G

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n No.

09/766,873

Applicant(s)

SU ET AL.

Examiner

Richard G Hutson

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 03 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-22, 26 and 30-35.

Claim(s) withdrawn from consideration: 23-25, 27-29.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
Richard G Hutson, Ph.D.  
Primary Examiner  
Art Unit: 1652

Continuation of 2. NOTE: Applicants proposed amendment and "remarks" attempt to correct potential antecedent problems between claims 1, 9 and 10 but if entered would still result a new rejection because if entered proposed claim 1 would include a "selective marker" and claim 9 would further include a "selective marker" (in addition to that of claim 1?). Claim 10, which depends from claim 9 and recites "said selective marker", would be unclear as to which of the previously referred to "selective markers" (that of claim 1 or the potential additional "selective marker" of claim 9).

Further applicants attention is directed to where in the specification as originally filed there exists support for the term "selective marker". Support for the "selectable marker" is found at page 5, lines 26-28, however support for the terms "selectiv marker" could not be found, which would further necessitate a 112 first paragraph rejection based on new matter.

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant's arguments have been fully considered but they are not persuasive based on the non-entry of applicants proposed amendments and the fact that applicants arguments are dependent on the proposed amended claims.

Claims 1-22, 26 and 30-35 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons previously stated and based on the non-entry of applicants amendment.

Claims 1-22, 26 and 30-35 remain rejected under 35 U.S.C. 112, first paragraph, for the reasons previously stated and based on the non-entry of applicants amendment.

Claims 1-11, 13-21, 26 and 30-35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman et al. (WO 96/01894 January 25, 1996) and McBride et al. (Applied and Environmental Microbiology, Vol. 62, No. 8, pages 3017-3022, August 1996) for the reasons previously stated and based on the non-entry of applicants amendment.